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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/626,954

07/27/2000

Frederick W. Ryan JR.

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07/05/2005

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EXAMINER

WOO, RICHARD SUKYOON

ART UNIT

PAPER NUMBER

3639

DATE MAILED: 07/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	09/626,954		RYAN, FREDERICK W.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Richard Woo		3639	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 April 2005.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-26 and 28-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 and 28-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>04-18-05</u> | 6) <input type="checkbox"/> Other: _____  |

*Tr*

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1) A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on April 18, 2005 has been entered.

### ***Claim Objections***

2) Claims 1 and 15 are objected to because of the following informalities:

In Claim 1, line 2, --subsidized by a mail campaign sender-- should be inserted after "indicium".

In Claim 1, line 4, "a" (before "mail campaign sender") should be changed to --the--.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

3) The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4) Claims 1-6, 9-12, 15-16, 19-20, 22, 25, 28-31, 36, 39 and 42 are rejected under 35 U.S.C. 102(e) as being anticipated by Heiden et al. (US 6,055,520).

As for Claim 1, Heiden et al. discloses a method comprising the step(s) of:

transmitting a registration ID number, provided by a mail campaign sender to a user, from the postage metering system to a data center, the registration ID number being associated with a delivery address previously defined by the mail campaign sender (see col. 5, lines 11-33, 61-63; col. 6, lines 19-28);

receiving postage indicium information at the postage metering system from the data center, the postage indicium information generated using the registration ID number and including data relating to the delivery address (see Id.); and

printing the postage indicium on the business reply mail piece at the postage metering system using the postage indicium information (see col. 8, lines 24-47; Fig. 5).

As for Claim 2, Heiden et al. further discloses the method, including the step(s) of:

printing the delivery address on the business reply mail piece at the postage metering system, where the delivery address has been selected, by the data center from a plurality of delivery addresses previously defined by the mail campaign sender, according to parameters associated with the user of the postage metering system that

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were previously established by the mail campaign sender (see Supra columns 5-6, 8).

As for Claim 3, Heiden et al. further discloses the method including the step(s) of:

receiving a subsidy provided by the data center to the user of the postage metering system for mailing the business reply mail piece (see Fig. 5 for the PSD in connection with the third party; Supra column 8).

As for Claim 22, Heiden et al. disclose the method including the step(s) of:

receiving a subsidy provided by the data center to the user of the postage metering system for mailing the business reply mail piece (see Supra column 8).

As for Claim 4, Heiden et al. discloses a method comprising the step(s) of:

receiving a delivery address from a mail campaign sender corresponding to a mail campaign of which the business reply mail piece is a part (see Fig. 5; column 8, lines 24-47);

generating a registration ID number corresponding to the delivery address (see col. 5, lines 11-33, 61-63; col. 6, lines 19-28);

providing the registration ID number to the mail campaign sender (see Fig. 5);

establishing a transaction session with a postage metering system (see Id.);

receiving the registration ID number from the postage metering system, where the registration ID number was previously provided by the mail campaign sender to a user of the postage metering system (see Supra Fig. 5 and column 8);

generating the postage indicium information using the registration ID number and data relating to the delivery address; and

transmitting the postage indicium intonation to the postage metering system for use in printing the postage indicium on the business reply mail piece (see Supra column 8).

As for Claim 5, Heiden et al. further discloses the method including the step(s) of: performing address hygiene on the delivery address; and transmitting a hygiened addressed to the sender (see Fig. 5 and col. 8, lines 24-47).

As for Claim 6, Heiden et al. further discloses the method including the step(s) of: providing a subsidy to the user for mailing the business reply mail piece; and charging the subsidy to the mail campaign sender (see the arrangement between the third party (mail campaign sender) and the user in Fig. 5; PSD in communication with the mail campaign sender).

As for Claim 25, Heiden et al. disclose the method including the step(s) of:

receiving a subsidy provided by the data center to the user of the postage metering system for mailing the business reply mail piece (see Supra column 8).

As for Claims 28-29, Heiden further discloses the method, including the step(s) of:

storing a plurality of delivery addresses previously defined by the mail campaign sender; and

selecting the delivery address for the business reply mail piece from the plurality of delivery addresses according to parameters, previously established by the mail

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campaign sender, associated with the user of the postage metering system (see Supra columns 5-6).

As for Claims 30-31, Heiden et al. further discloses the method including the step(s) of:

providing a notification to the mail campaign sender when business reply mail piece is posted by the user (see Fig. 2 and col. 6, lines 35-67).

As for Claim 39, Heiden et al. further discloses the method including the step(s) of:

sending a message to the mail campaign sender indicating that the user has dispatched the business reply mail piece (see col. 6, lines 35-67).

As for Claim 9, Heiden et al. discloses a method comprising the step(s) of:

providing a delivery address, associated with a particular mail campaign which includes a business reply mail piece, to a data center (see col. 5, line 11-34; col. 8, lines 24-47);

receiving from the data center a registration ID number associated with the delivery address (see Id.); and

supplying the registration ID number and the business reply mail piece to a user, where the registration ID number is used by the user to print a postal indicium on the business reply mail piece including data relating to the delivery address (see Fig. 5 and Supra column 8).

As for Claim 10, Heiden et al. further discloses the method including the step(s) of:

receiving from the data center a new hygiened address representing a version of the delivery address prior to supplying the registration ID number and the business reply mail piece to the user, where the new hygiened address is to be used as the delivery address (see Supra columns 5-6, 8).

As for Claim 11, Heiden et al. further discloses the method including the step(s) of: printing the registration ID number on the business reply mail piece (see Fig. 5).

As for Claim 12, Heiden et al. further discloses the method including the step(s) of:

authorizing the data center to provide a subsidy to the user for mailing the business reply mail piece (see Fig. 5 the arrangement between PSD and the data center); and

authorizing the data center to charge the subsidy to the mail campaign sender.

As for Claim 34, Heiden et al. further discloses the method including the step(s) of:

defining a plurality of delivery addresses; and

establishing parameters for use in determining a selected one of the plurality of delivery address to use as the delivery address on the business reply mail piece, where the parameters are associated with the user of the postage metering system (see Supra columns 5-6).

As for Claim 42, Heiden et al. further discloses the method including the step(s) of:

receiving a message from the data center indicating that the user has dispatched the business reply mail piece (see Supra column 6).



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As for Claim 15, Heiden et al. discloses a memory device accessible by a computing system, the memory device comprising:

a plurality of mail campaign sender accounts (PSD in Fig. 5) associated with respective mail campaign senders, where each of the plurality of mail campaign sender accounts includes a registration ID number associated with a delivery address and a particular mail campaign of which a business reply mail piece is a part, respectively, and where said registration ID number is used to generate a postage indicium (see col. 5, lines 11-33, 61-63; col. 6, lines 19-28; col. 8, lines 24-47).

As for Claim 16, Heiden et al. further discloses the memory device, wherein:

at least one of the plurality of mail campaign sender accounts further includes an indication associated with the registration ID number to determine whether or not the respective mail campaign sender authorizes a subsidy to a user for mailing the business reply mail piece (see Fig. 5 and Supra column 8).

As for Claim 36, Heiden et al. further discloses the memory device, wherein:

some of the plurality of mail campaign sender accounts further include: (i) a plurality of delivery addresses; and (ii) parameters for use in determining a selected one of the plurality of delivery address to use as the delivery address on the business reply mail piece, where the parameters are associated with the user of the postage metering system (see Supra columns 5-6).

As for Claim 19, Heiden et al. discloses a mail piece, comprising:

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a registration ID number printed thereon and wherein the registration ID number is associated with a mail campaign sender, a previously defined delivery address and a particular mail campaign of which the business reply mail piece is a part (see col. 5, lines 11-33, 61-63; col. 6, lines 19-28; col. 8, lines 24-47); and

a postage indicium generated using said registration ID number and including data relating to said previously defined delivery address (see Fig. 5 and Supra column 8).

As for Claim 20, Heiden et al. discloses the mail piece, wherein the previously defined delivery address is also printed thereon (see Supra columns).

### ***Claim Rejections - 35 USC § 103***

5) The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6) Claims 7-8, 13-14, 17-18, 21, 23-24, 26, 32-33, 35, 37-38, 40-41 and 43-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heiden et al. in view of Allott, III (US 6,121,565).

Heiden et al. discloses the method and device as recited above, but does not expressly disclose the invention further comprising:

receiving an expiration date from the mail campaign sender; and  
providing a warning to for attempting to reply after the expiration date.

Allott, III teaches, for a method of delivery a business reply mail piece using  
expiring indicia, that the method comprises:

receiving an expiration date from the mail campaign sender; and  
providing a warning to for attempting to reply after the expiration date.

Since Allott and Heiden et al. are both from the same field of endeavor, the  
purpose disclosed by Allott would have been well recognized in the pertinent art of  
Heiden et al..

Accordingly, it would have been further obvious at the time the invention was  
made to a person having ordinary skill in the art, to utilize the delivery system using  
expiring indicia with a manifested time in the mail delivery system of Heiden et al., as  
taught by Allott, for the purpose of providing extremely effective method of decreasing  
the time between billing and remittance by positively reinforcing early return of business  
reply mail piece.

### ***Conclusion***

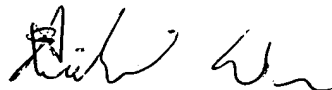
7) Any inquiry concerning this communication or earlier communications from the  
examiner should be directed to Richard Woo whose telephone number is 571-272-

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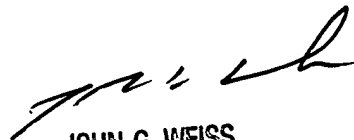
6813. The examiner can normally be reached on Monday-Friday from 8:30 AM -5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Richard Woo  
Patent Examiner  
Art Unit 3639  
June 22, 2005.



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TECHNOLOGY CENTER 3300